

REMARKS

Applicant has amended claims 1, 8, 9, 10, 13, and 15 to more particularly and distinctly point out the claimed subject matter. Applicant has cancelled claim 18. Support for the amendments to claims 1, 9, and 10 can be found in the as-filed specification, e.g., at pages 8-52, and 76; Tables 23-66. Support for amended claims 8 and 15 can be found in the as-filed specification, e.g., at page 76. Support for amended claim 13 can be found in the as-filed specification, e.g., at page 87. No new matter has been introduced. Claims 1 and 4-17 are currently pending.

Applicant respectfully traverses the rejection of claims 1, 4-7, 9-14, and 16-18 under 35 U.S.C. § 102(b) over JP 2002-097486 to Shimomura et al. ("Shimomura JP").

Cancellation of claim 18 obviates the rejection of this claim.

Amended claims 1 and 10 each recites, among other things, a base oil consisting of at least one type selected from mineral oils, hydrocarbon-based oils, aromatic esters, esters of C5-C10 linear aliphatic dibasic acids, polyesters, complex esters, carbonic acid esters, polyoxyalkylene glycols, polyvinyl ethers, ketones, polyphenyl ethers, silicones, polysiloxanes, and perfluoroethers.

The transitional phrase "consisting of" used in amended claims 1 and 10 excludes any other type of base oil not recited in the claims. See M.P.E.P. § 2111.03. Shimomura JP discloses expressly or inherently none of the above base oils recited in amended claims 1 and 10, and instead teaches base oils not recited in the claims. For example, the Office Action relied on paragraphs [0039]-[0041] of Shimomura JP to purportedly teach "an ester lubricant that can be formed by C1-C20 straight -chain alkyl monoesters of a monobasic fatty acid having 12 or more carbon atoms and a monohydric alcohol having 1-24 carbon atoms (oil gent of claim 1 and ester oil agent as

recited in claim 5 and linear dibasic acid and monohydric alcohol of claims 6-7, 10 and 14)." Office Action, page 3. Applicant respectfully submits that Shimomura JP at paragraphs [0039]-[0041] does not disclose the above-quoted feature alleged in the Office Action and instead discloses various types of acids and alcohols to form esters of alicyclic dibasic acids and monohydric alcohols. See also Shimomura JP, paragraphs [0017]-[0021].

The Office Action also asserted that "Shimomura JP discloses the same base oil recited in the instant claims and would therefore inherently have a pour point that is within the recited range." Office Action, page 3. As discussed above, claims 1, 9, and 10, as amended, excludes esters of alicyclic dibasic acids and monohydric alcohols, as disclosed in Shimomura JP. Accordingly, Shimomura JP fails to disclose the base oil as recited in amended claims 1 and 10, and does not inherently disclose the claimed pour point range.

Amended claim 1 also recites, an oil agent selected from among butyl stearate, diisobutyl adipate, diisodecyl adipate, glycerin monooleate, glycerin trioleate, oleyl alcohol, and glyceryl ether, none of which is disclosed in Shimomura JP.

For at least the foregoing reasons, Shimomura JP fails to disclose all of the features of amended claims 1 and 10. Amended claims 1 and 10 therefore are allowable over Shimomura JP. Claims 4-7, 9, 11-14, and 16-17 depend from one of claims 1 and 10, respectively, and incorporate all of the features recited in the claim from which they depend. Accordingly, claims 4-7, 9, 11-14, and 16-17 also are allowable over Shimomura JP.

Applicant respectfully traverses the rejection of claims 1 and 4-18 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,667,285 to Kawahara et al. ("Kawahara") in view of U.S. Patent No. 6,228,282 to Shimomura et al. ("Shimomura").

Cancellation of claim 18 obviates the rejection of this claim.

Amended claims 1 and 10 recites, among other things, a base oil consisting of at least one type selected from mineral oils, hydrocarbon-based oils, aromatic esters, esters of C5-C10 linear aliphatic dibasic acids, polyesters, complex esters, carbonic acid esters, polyoxyalkylene glycols, polyvinyl ethers, ketones, polyphenyl ethers, silicones, polysiloxanes, and perfluoroethers. Amended claims 1 and 10 each excludes any type of base oil not recited in the amended claims 1 and 10.

In contrast, Kawahara, throughout its entire disclosure, teaches a mixture of an ester (a) (i.e., at least one aliphatic saturated branched-chain carboxylic acid monoalkyl ester represented by the formula (1) shown in claim 1 of Kawahara) and a combination base oil (b), as an essential element to improve hydrostatic stability and viscosity. See e.g., Kawahara, col. 3, line 16- col. 4, line 26. The ester (a) of Kawahara is excluded from the base oil recited in amended claims 1 and 10. Kawahara therefore fails to disclose or suggest a base oil, as recited in amended claims 1 and 10. Kawahara also teaches away from claims 1 and 10, in which the ester (a) of Kawahara is excluded, by expressly disclosing the advantages of using them as base oils.

One of ordinary skill in the art, without any knowledge of the claimed invention, therefore would not have had any legitimate reason to use Kawahara's teachings to arrive at the claimed oil composition, with a reasonable expectation of success. Shimomura does not remedy the deficiency in Kawahara.

For at least the foregoing reasons, Applicant respectfully submits that Kawahara in view of Shimomura does not render obvious the claimed refrigerating machine oil composition. Amended claims 1 and 10 are allowable over Kawahara in view of Shimomura.

Claims 4-9 and 11-17 depend from claims 1 and 10 respectively, and incorporate all of the features of amended claims 1 and 10. Claims 4-9 and 11-17 also are allowable over the combination of Kawahara and Shimomura for at least the same reasons as those set forth above for amended claims 1 and 10.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 11, 2010

By: /Hojung Cho/
Hojung Cho
Ltd. Rec. No. L0596
(202) 408-4000